

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAO IGARASHI, TAKASHI MINEGISHI
and KAZUTO NAKAMURA

Appeal No. 95-3499
Application 07/757,342¹

ON BRIEF

Before WILLIAM F. SMITH, GRON and ELLIS, **Administrative Patent Judges**.

ELLIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 13 and 14, all the claims pending in the application. Claims 2-12 have been canceled.

¹ Application for patent filed September 10, 1991.

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Claims 1 and 13 are illustrative of the subject matter on appeal and read as follows:

1. An isolated human luteinizing hormone-human chorionic gonadotropin receptor protein, in which said isolated protein has an amino acid sequence represented by (i) SEQ ID NO:2, an amino acid sequence having the 1st to 699th amino acid residues of SEQ ID NO: 1, or (ii) by SEQ ID NO:7, an amino acid sequence lacking the 227th to 289th amino acid residues of SEQ ID NO: 2.

13. A pharmaceutical composition comprising an effective amount of an isolated human luteinizing hormone-human chorionic gonadotropin receptor protein and a pharmaceutically acceptable carrier or vehicle.

The reference relied upon by the examiner is:

Rosemblit et al. (Rosemblit), "Characterization of an Antiserum to the Rat Luteal Luteinizing Hormone/Chorionic Gonadotropin Receptor", **Endocrinology**, Vol. 123, No. 5, pp. 2284-2290 (May 1998)

Claims 1, 13 and 14 stand rejected under 35 USC § 103 over Rosemblit.

We have carefully considered the respective positions of the appellants and the examiner and find ourselves in substantial agreement with that of the appellants.

Accordingly, we **reverse**.

As we understand it, the examiner's overall position is that since the rat luteinizing hormone-human chorionic gonadotropin (LH/GH) receptor was purified from rat luteal tissue, it would have been obvious to one of ordinary skill in the art to isolate the human receptor protein (LH/hCG) because "the commercial value of a protein or protein related product lies in its utility in human subjects." Answer, p. 4. However, in reviewing the Rosemblit reference relied upon by the examiner, it is difficult to discern on what basis

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this conclusion was reached since Rosembliit does not teach, or even suggest isolating, the claimed LH/hCG. To the contrary, the only mention we find of LH/hCG is in the appellants' specification. Thus, we agree with the appellants that the examiner has engaged in impermissible hindsight to arrive at the conclusion that the claimed invention would have been obvious over Rosembliit. ***In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); ***Interconnect Planning Corp v. Feil***, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); ***W.L. Gore & Assocs. v. Garlock, Inc.***, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983) ***cert. denied*** 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher").

Accordingly, the rejection is reversed.

Other Issues

Upon return of this application to examining corps, the examiner should clarify the record as to its effective filing date. It is noted that the applicants have claimed priority, under 35 USC § 119, of two Japanese patent applications, and they have provided certified copies thereof. However, there are no certified translations of said applications in the file; nor any indication by the examiner as to whether the application has been

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accorded the benefit of the foreign filing dates. Clarification of this issue appears to be critical in view of the teachings of PCT application WO 90/13643, of record in the file. See Paper No. 15. Attention is directed to p. 14 of the PCT which discusses the conservation of the structure and sequence between various mammalian LH/CG receptors and how the cDNA sequence of the rat LH/CG receptor (shown in Figure 6), can be used to isolate the human LH/GC receptor. The examiner should consider the relevance of these teachings.

REVERSED

William F. Smith)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
Teddy S. Gron)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
Joan Ellis)	
Administrative Patent Judge)	

JE/dm

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